

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS: David G. Kuchr-McClaren, Martin Presler-Marshall, Calvin S. Powers,
John H. Walczyk III and Timothy Shoriak

APPLICATION NO. 10/706,334 Confirmation No. 6032

FILED: November 11, 2003 Examiner: EVENS J. AUGUSTIN

CASE NO. RSW920010113US1 Group Art Unit: 3621

TITLE: METHOD, SYSTEM, AND COMPUTER PROGRAM PRODUCT
FOR DIGITAL VERIFICATION OF COLLECTED PRIVACY
POLICIES IN ELECTRONIC TRANSACTIONS

FILED ELECTRONICALLY ON April 25, 2008

MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

APPELLANTS' BRIEF

This Appeal Brief is in furtherance of the Notice of Appeal filed in this case on February 25, 2008. The Commissioner is authorized to charge the fee for filing of this Appeal Brief to Deposit Account No. 09-0447.

1. REAL PARTY IN INTEREST

The present application is assigned to International Business Machines Corporation, having its principal place of business at New Orchard Road, Armonk, New York 10504. Accordingly, International Business Machines Corporation is the real party in interest.

2. RELATED APPEALS AND INTERFERENCES

The Appellants, assignee, and the legal representatives of both are unaware of any other appeal or interference which will be directly affected by or have a bearing on the Board's decision in this appeal.

3. STATUS OF CLAIMS

- A. Claims canceled: None
- B. Claims withdrawn from consideration but not canceled: None
- C. Claims pending: 1-18
- D. Claims allowed: none
- E. Claims rejected: 1-18
- F. Claims appealed: 1-18

Appealed claims 1-18 as currently pending are attached as the Claims Appendix hereto.

4. STATUS OF AMENDMENTS

A Reply under 37 CFR §1.111 was filed on September 4, 2007, and claim amendments were made. In response, the Examiner issued the final Office Action appealed herein.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

Claim 1: A method of conducting electronic commerce transactions among a plurality of participants in an E-marketplace, comprising the steps of:

the E-marketplace obtaining digitally-signed privacy-use information for each participant

(page 10, lines 3-7; Fig. 3, step 304); and

the E-marketplace sharing the digitally-signed privacy-use information with any

participants interested in doing business with each other in the E-marketplace

(page 10, lines 8-17; Fig. 3, steps 306 and 308).

Claim 7: A computer program product recorded on computer-readable medium for conducting electronic commerce transactions among a plurality of participants in an E-marketplace, comprising:

computer-readable means for the E-marketplace obtaining digitally-signed privacy-use

information for each participant (page 10, lines 3-7; Fig. 3, step 304); and

computer-readable means for the E-marketplace sharing the digitally-signed privacy-use

information with any participants interested in doing business with each other in

the E-marketplace (page 10, lines 8-17; Fig. 3, steps 306 and 308).

Claim 13: A system for conducting electronic commerce transactions among a plurality of participants in an E-marketplace, comprising:

means for the E-marketplace obtaining digitally-signed privacy-use information for each participant (page 10, lines 3-7; Fig. 3, step 304); and

means for the E-marketplace sharing the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace (page 10, lines 8-17; Fig. 3, steps 306 and 308).

In accordance with 37 CFR 41.37(c)(1)(vii), the structure, materials, or acts corresponding to each the means plus function clause recited in claim 13 is identified and described in the portions of the specification which are cited immediately following each clause of claim 13, above, as well as in page 12, line 6 through page 13, line2 of the specification.

The present claimed invention teaches a method, computer program product and system for using a digital signature in privacy policies submitted to an E-Marketplace where electronic transactions are conducted. In the claimed invention, the E-marketplace obtains digitally signed privacy-use information (privacy policy) from each of a plurality of participants and then shares the digitally signed privacy information with any participants interested in doing business with each other. The E-marketplace is discussed on page 7, lines 2-15 of the specification and shown in Figs. 1 and 2 as being a distinct entity that is coupled to a plurality of participants including buyers, sellers and third parties through a network such as the internet. The E-marketplace receives communications from the

buyers, sellers and third parties; stores information for viewing by the participants; and stores information relating to transactions that occur in the E-marketplace. Thus, the E-marketplace is a separate entity from the plurality of participants in the E-marketplace.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellants request the Board to review the following rejections:

A. Rejection of claims 1-18 under 35 U.S.C. §102(e) as being anticipated by U.S.

Patent Application No. 20060075122 to Linskog et al. ("Linskog").

7. ARGUMENT

Rejection of Claims 1-18 under 35 U.S.C. §102(e) as being anticipated by Linskog

The Examiner Has Not Established a *Prima Facie* Case of Anticipation

As set forth in the MPEP:

AA claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. @ MPEP ' 2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)

The Examiner Has Not Established a *prima facie* Case of Anticipation

The claims of the present invention recite that digitally-signed privacy-use information is obtained by an E-marketplace for each of a plurality of participants. Then, the E-marketplace shares the privacy information with the participants in the E-marketplace. The nature of problem solved by the present claimed invention is that the privacy-use information is under the control of an intermediary (the E-marketplace) after it is submitted by one participant and before it is shared with

another participant, so that a third party has an opportunity to modify privacy policy. The integrity of the digital signature ensures that privacy policies are not tampered with while under the control of the E-marketplace. By including a digital signature in a privacy policy submitted to the E-marketplace by a participant, other participants that subsequently receive the privacy policy from the E-marketplace can ensure the integrity of the privacy policy by ensuring that the digital signature has not been altered by the E-marketplace or any other intermediary. Such assurance prevents an unscrupulous E-marketplace administration from modifying a submitted privacy policy before sharing it with the other participants and prevents an unscrupulous vendor from later denying the terms of the policy as being valid.

In contrast to the present invention, nowhere does Lindskog teach that a privacy policy is obtained by an intermediary from one entity and then shared by the intermediary with a second entity. Rather, the privacy policy of Lindskog is transmitted only once, from a single content provider to a single user agent. Lindskog teaches that a single user (through the use of a user agent that is associated with the user or provided in the user equipment) (page 2, paragraph [0017] of Lindskog) generates a receipt when the user accepts a privacy policy file that has been transmitted by the content provider to the user agent (Abstract of Lindskog). First, the user agent of Lindskog requests a resource over the internet from a content provider on behalf of a user. In response, the content provider transmits a privacy policy file containing information regarding the usage of cookies to the user agent. The user agent then transmits a cookie receipt back to the content provider specifying whether the user accepts the policy. As a result, the content provider is made aware of whether the user will permit the content provider to transmit a cookie along with the requested resource. The invention of Lindskog only discloses the existence of one privacy policy file (that of the content provider) and the privacy policy file is only transmitted one time (from the content provider to the

user agent). Thus, the problem of ensuring the integrity of the policy while it is under the control of an intermediary does not even exist in Linskog. The invention of Linskog does not teach that a privacy policy file is ever transmitted to any type of intermediary at any time and does not teach that any other privacy policy files other than that of the content provider are transmitted at any time.

Response to the Examiner's Arguments

On page 2 of the Office Action, in the section entitled Response 1, the Examiner states that "the PTO has not been able to find the aspect of the policy being transmitted to an intermediary at any time in the claims." However, each independent claim in the present application clearly states that the E-marketplace obtains digitally-signed privacy-use information for each participant and the E-marketplace shares the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace. Thus, the E-marketplace acts as an intermediary between participants to transactions by obtaining digitally-signed privacy-use information from each entity/participant (each one of the claimed plurality of participants) and then sharing the digitally-signed privacy-use information with each other entity/participant (each one of the "any participants interested in doing business with each other in the E-marketplace").

Additionally, the Examiner proceeds to discuss an example where a computer server hosts a website for a company and offers services and resources. However, nowhere in the Examiner's example is there any mention of any entity that performs the steps of the E-marketplace in the present invention, i.e., obtaining digitally-signed privacy-use information for each participant and then sharing the digitally-signed privacy-use information with every other participant interested in

doing business with each other in the E-marketplace. Also, the Examiner's example does not appear to bear any relation to the invention of Lindskog. Thus, Applicants are unclear as to the relevance of the Examiner's example.

On page 2-3 of the Office Action, in the section entitled Response 2, the Examiner first cites the Merriam Webster definition of the word "entity" and then incorrectly states that the entities per Applicant's invention are (1) web hosting (which is not mentioned anywhere in the claims of the present application), (2) the company selling the goods/services and (3) users. In actuality, the entities of Applicant's invention are the E-marketplace and any two of the participants in the E-marketplace who are interested in doing business with each other. The E-marketplace obtains a privacy policy from each participant and transmits a privacy policy to each participant.

Next, in relating his arguments to Lindskog, first the Examiner correctly points out the single instance of the giving of a privacy policy in the invention of Lindskog (user's opportunity to accept or reject content provider's policy as described in paragraphs [0022] to [0024]). Subsequently the Examiner incorrectly states that paragraph [0017] of Lindskog discloses that a third party obtains a privacy policy from a seller and third party shares the policy with the user. What paragraph [0017] of Lindskog actually discloses is that "a user agent associated with or provided in the user equipment receives a privacy policy for the content provider." Thus, only one privacy policy is obtained from one entity in paragraph [0017] of Lindskog (the user agent obtaining from the content provider). Under the Examiner's cited definition of "entity", the user agent in Lindskog is not a different entity than the user because it is not a "separate, independent

existence from the user.” Rather, the user agent is provided in the user equipment. Additionally, nowhere does the user agent in Lindskog share the content provider’s privacy policy with any entity. And, unlike the present claimed invention which obtains digitally-signed privacy-use information for each participant, nowhere does the user agent in Lindskog obtain any other privacy policy from of any other entity than the content provider and then share that other obtained privacy policy with the content provider. For these reasons, Lindskog does not disclose or suggest the present claimed invention.

The Examiner maintains that obtaining digitally-signed privacy-use information for each participant as recited by claim 1 is disclosed by the following language in Lindskog:

User clicks on seller website for content, and a third party obtains a privacy policy from the seller (paragraphs [0017] and [0046] of Lindskog) – The invention deals with usage in a P3P agreement procedure for providing resources from content providers over the internet (marketplace) (paragraph [0025])”

The Examiner further maintains that paragraphs [0017], [0018] and [0046] of Lindskog teach “sharing the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace.”

It is still unclear what element of Lindskog is being asserted by the Examiner to be the same as the E-marketplace of the present invention. The Examiner continues to alternatively state that the internet in Lindskog and the user in Lindskog are the same as the E-marketplace in the present claimed invention. However, neither the internet nor the user agent of Lindskog are the same as the E-marketplace of the present invention. Rather, the E-marketplace in the present invention is an entity that obtains a privacy policy from one participant and the shares the policy with another participant and internet is simply used to transfer the information in Lindskog from

the content provider to the user agent and is similarly shown in Figs. 1 and 2 of the present application as being used to transfer information between the E-marketplace and the various participants in the E-marketplace. Nowhere does Lindskog disclose that the internet is a distinct entity which obtains privacy-use information from one entity and then shares it with another entity.

Additionally, the user of Lindskog is not the same as the participant in the presently claimed invention with whom the privacy-use information is shared, as maintained by the Examiner. The user and the user agent in Lindskog are both part of the same node in the transmission of the privacy file. The privacy policy file is transmitted to the user agent, and the user agent specifies whether the user accepts the policy or not without any further transmission of the privacy policy file. The content provider is the only entity that transmits a privacy policy. Nowhere does Lindskog disclose that the user agent must explicitly share the privacy policy file with the user as one entity would have to share it with another entity or that privacy information is obtained from each participant as recited in the claims of the present invention.

Each of the independent claims expressly recite the above elements that are neither taught nor suggested by Lindskog. Accordingly, each of the independent claims (Claims 1, 7 and 13), and all claims depending therefrom, patentably define over Lindskog and are in condition for allowance.

8. CONCLUSION

For the foregoing reasons applicants respectfully request this Board to overrule the Examiner's rejections and allow Claims 1-18.

Respectfully submitted,

April 25, 2008

Date

/Frank T. Carroll/

Frank T. Carroll

Reg. No. 42,392

Synnestvedt & Lechner LLP

1101 Market Street

Suite 2600

Philadelphia, PA 19107

Telephone: 215-923-4466

Facsimile: 215-923-2189

CLAIMS APPENDIX

CLAIMS INVOLVED IN THIS APPEAL:

1. (Previously Presented) A method of conducting electronic commerce transactions among a plurality of participants in an E-marketplace, comprising the steps of:

the E-marketplace obtaining digitally-signed privacy-use information for each participant;

and

the E-marketplace sharing the digitally-signed privacy-use information with any

participants interested in doing business with each other in the E-marketplace.

2. (Original) The method of claim 1, wherein said privacy information comprises a P3P policy.

3. (Original) The method of claim 1, wherein said step of obtaining digitally-signed privacy-use information for each participant comprises at least the steps of:

requesting each participant to submit said digitally-signed privacy-use information to the

E-marketplace as part of a registration procedure for the E-marketplace; and

storing all of said submitted digitally-signed privacy-use information by the E-marketplace.

4. (Original) The method of claim 1, wherein said step of obtaining digitally-signed privacy-use information for each participant comprises at least the steps of:

requiring each participant to submit said digitally-signed privacy-use information to the E-

marketplace as part of a registration procedure for the E-marketplace; and

storing all of said submitted digitally-signed privacy-use information by the E-marketplace.

5. (Original) The method of claim 4, wherein said step of sharing the digitally-signed privacy-use information comprises at least the step of:

said E-marketplace making available all of said stored digitally-signed privacy-use information to all participants upon request.

6. (Original) The method of claim 4, wherein said step of sharing the digitally-signed privacy-use information comprises at least the step of:

said E-marketplace making available to participants in a particular transaction the stored digitally-signed privacy-use information of all participants in said particular transaction.

7. (Previously Presented) A computer program product recorded on computer-readable medium for conducting electronic commerce transactions among a plurality of participants in an E-marketplace, comprising:

computer-readable means for the E-marketplace obtaining digitally-signed privacy-use information for each participant; and

computer-readable means for the E-marketplace sharing the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace.

8. (Original) The program product of claim 7, wherein said privacy information comprises a P3P policy.

9. (Original) The program product of claim 7, wherein said computer-readable means for obtaining digitally-signed privacy-use information for each participant comprises at least:

computer-readable means for requesting each participant to submit said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace; and

computer-readable means for storing all of said submitted digitally-signed privacy-use information by the E-marketplace.

10. (Original) The program product of claim 7, wherein said computer-readable means for obtaining digitally-signed privacy-use information for each participant comprises at least:

computer-readable means for requiring each participant to submit said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace; and

computer-readable means for storing all of said submitted digitally-signed privacy-use information by the E-marketplace.

11. (Original) The program product of claim 10, wherein said computer-readable means for sharing the digitally-signed privacy-use information comprises at least:

computer-readable means for making available by said E-marketplace all of said stored digitally-signed privacy-use information to all participants upon request.

12. (Original) The program product of claim 10, wherein said computer-readable means for sharing the digitally-signed privacy-use information comprises at least:

computer-readable means for making available to participants in a particular transaction, by said E-marketplace, the stored digitally-signed privacy-use information of all participants in said particular transaction.

13. (Previously Presented) A system for conducting electronic commerce transactions among a plurality of participants in an E-marketplace, comprising:

means for the E-marketplace obtaining digitally-signed privacy-use information for each participant; and

means for the E-marketplace sharing the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace.

14. (Original) The system of claim 7, wherein said privacy information comprises a P3P policy.

15. (Original) The system of claim 7, wherein said means for obtaining digitally-signed privacy-

use information for each participant comprises at least:

computer-readable means for requesting each participant to submit said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace; and
means for storing all of said submitted digitally-signed privacy-use information by the E-marketplace.

16. (Original) The system of claim 7, wherein said means for obtaining digitally-signed privacy-use information for each participant comprises at least:

means for requiring each participant to submit said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace; and
means for storing all of said submitted digitally-signed privacy-use information by the E-marketplace.

17. (Original) The system of claim 10, wherein said means for sharing the digitally-signed privacy-use information comprises at least:

means for making available by said E-marketplace all of said stored digitally-signed privacy-use information to all participants upon request.

18. (Original) The system of claim 10, wherein said means for sharing the digitally-signed privacy-

use information comprises at least:

means for making available to participants in a particular transaction, by said E-
marketplace, the stored digitally-signed privacy-use information of all participants
in said particular transaction.

EVIDENCE APPENDIX

No additional evidence is presented.

RELATED PROCEEDINGS APPENDIX

No related proceedings are presented.